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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PICH, PONNOREAY

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,605

Applicant(s)

MATENA, VLADIMIR

Examiner

Ponnoreay Pich

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/5/2006 has been entered.

Claims 1-4 and 7-23 are pending. Applicant's amendments and arguments have been considered, but are moot in view of new rejections presented below.

Priority

The examiner notes that the current application appears to be a continuation of application 09/023,074, now US patent 6,243,814, which is a continuation of application 08/55,316, now US patent 5,996,075. However, applicant's oath does not make any mention of claim to priority to either one of these patent documents. Applicant is advised that until the oath properly claims priority to these documents, the current application cannot officially be granted an effective filing date of 11/2/1995. Instead, the effective filing date would be considered 11/20/2000, the actual filing date of the application. Applicant is also respectfully advised to include such information in the specification in a "CROSS-REFERENCE TO RELATED APPLICATIONS" section as such information is usually placed at the beginning of the specification (after the title, see 37 CFR 1.77b) or in an Application Data Sheet. The examiner does not see an

Application Data Sheet filed for applicant and there is no "CROSS-REFERENCE TO RELATED APPLICATIONS" section currently in the specification.

Oath/Declaration

As noted above, the oath does not claim priority back to earlier applications and patents owned by applicant even though it is a continuation of those applications and patents. Applicant is advised to claim proper priority in the oath if applicant wishes for the current application to be treated as having an effective filing date of 11/2/1995.

Claim Objections

Claim 17 is objected to because of the following informalities: The "a" in the next to last line of claim 17 should be "at". Appropriate correction is required.

Terminal Disclaimer

The terminal disclaimer filed on 2/14/2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 5,996,075 had been reviewed and was accepted. The terminal disclaimer had been recorded.

As such, any claims that might have been rejected under obviousness double patenting will not be rejected for double patenting. However, any claims that can be rejected under statutory double patenting will be rejected as a terminal disclaimer cannot be used to overcome a statutory double patenting rejection, see below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 and 7-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claims 1-4 and 7-23 are indefinite because applicant refers to several items as "said <object>" and "the <object>". It is unclear if "said <object>" and "the <object>" are meant to refer to the same items or different items. Using claim 1 as an example, in line 6, "the first value" is recited. In line 11, "said first value" is recited, i.e. "said first and second values", and in the dependent claims also applicant uses both "said" and "the" first value. It is unclear which first value is meant to refer back to "a first value" as recited in line 5 of claim 1. It is unclear if both are meant to refer back to "a first value" recited in line 5. If both are not meant to refer back to the same "a first value", it is unclear which lacks antecedent basis, "the first value" or "said first value". The examiner notes that if both "the first value" and "said first value" are meant to refer back to "a first value", then the inconsistent use of "said" and "the" in referring back to the same item makes the claim indefinite as it implies that they can refer back to separate first values.
2. Claim 1 recites "the peripheral device", which lacks antecedent basis. It is unclear if "the peripheral device" is meant to refer to "a shared peripheral device".
3. As per claim 1, it is unclear if perhaps applicant meant for the final limitation, i.e. repeating steps 5 and 6..., to be a 7th step (i.e. labeled with a 7) or if applicant

meant for the final limitation to be a part of step 6. Note that if applicant did not mean for the final limitation to be a 7th step, the repeating is only done if the first and second values are identical. The examiner assumes applicant meant to label the last limitation as a 7th step.

4. Claim 7 recites "the shared resource", which lacks antecedent basis. It is unclear if "the shared resource" is meant to refer back to "at least one shared peripheral resource as recited in lines 12 and if so, which one of the at least one share peripheral resource is being referred.
5. Claim 7 recites "the invention" in line 6, which lacks antecedent basis.
6. Claim 7 recites "the nodes" which lacks antecedent basis. It is unclear if "the nodes" is meant to refer to "a plurality of nodes" as recited in line 4.
7. Claim 7 recites "the membership" in line 9, which lacks antecedent basis. The examiner assumes applicant may have just meant "membership".
8. Claim 7 recites "said requesting node" in lines 18 and 19, which lacks antecedent basis. It is also unclear which requesting node of "at least one said requesting node" of line 18 is being referred to by "said requesting node"
9. Claim 7 recites "the unique value stored at said resource controller" in the last two lines, which lacks antecedent basis. Claim 7 did not earlier state anywhere that there is a unique value stored at said resource controller.
10. Claim 8 is indefinite because claim 8 recites "wherein said configuration value module is configured to determine said unique value...." The examiner notes that it is unclear which unique value is being referred to in claim 8 since claim 7

- from which claim 8 depends recites more than one unique value. The unique value in claim 7 associated with the configuration value module in claim 7 was recited in claim 7 as being generated. It is unclear if this is the unique value determined in claim 8, i.e. the determining in claim 8 is the generating in claim 7.
11. Claim 9 recites "said unique value". It is unclear to which unique value is being referred since claim 7 recites more than one unique value.
12. Claims 10-13 recite "said shared resource", which lacks antecedent basis. It is unclear if perhaps applicant meant "said peripheral resource".
13. Claim 14 and its dependent claims recite "said second value", which lacks antecedent basis. It is unclear "said unique value" refers back to "a second unique value" recite 13 of claim 14.
14. Claim recites "the system" which lacks antecedent basis. It is unclear if "the system" refers back to "a multinode system" in line 3.
15. Claim 17 recites many limitations substantially similar to claim 7, yet these limitations have differing comma usage in claim 17 and 7, thus the way these limitations are read are different and the meaning of each are different. Applicant is respectfully asked to double check comma usage in the claims to determine if applicant meant for them to be different between claims 17 and 7 or if applicant accidentally misused commas in one of the claims. The examiner assumes applicant meant to use commas similarly in both claims.
16. Claim 17 recites "the nodes" in lines 6-7, which lacks antecedent basis. It is unclear if "the nodes" refers back to "a plurality of nodes" in line 3.

17. Claim 17 recites "the membership" in line 8, which lacks antecedent basis. The examiner assumes applicant may have just meant "membership".
18. Claim 17 recites "said requesting node" in the last line. It is unclear which node of "at least one requesting node" is being referred to.
19. Claim 17 recites "the unique value stored at said resource controller" in the last two lines, which lacks antecedent basis. Claim 17 did not earlier state anywhere that there is a unique value stored at said resource controller.
20. Claims 18-22 recite "said shared resource", which lacks antecedent basis.
21. As per claim 23, it is unclear to which unique value recited in claim 17 "the unique value" is meant to refer. More than one unique value is recited in claim 17.
22. Any claims not specifically addressed are rejected by virtue of dependency.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 7-13 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 6-12 respectively of prior U.S. Patent No. 5,996,075. This is a double patenting rejection.

Allowable Subject Matter

Claims 1-4 and 14-23 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

As per claim 1, the examiner did not find teachings in the prior art of:

1. Determining a first list of nodes in the multinode system, including the processor-based node, that have access to the shared peripheral device;
2. Generating a first value reflecting the first list of nodes;
3. Storing at the shared peripheral device the first value;
4. Sending an access request from the processor-based node to the shared device, the request including a second value representing a second list of nodes in the multinode system;
5. Determining whether the first and second values are identical;
6. If the first and second values are identical, then executing the access request to the shared peripheral device; and
7. Repeating steps 5 and 6 each time an access request is sent from the processor-based node to the shared peripheral device.

The examiner notes that claim 1 recites limitations substantially similar to what is recited in claim 1 of US patent 5,996,075, but claim 1 is narrower in scope. Claims 2-4 are dependent on claim 1. Claims 14-16 are directed towards a computer usable medium having computer code embodied therein, the computer readable code comprising modules for implementing the method substantially similar to what is recited in claims 1-3 respectively.

Claim 17 as amended recites limitations substantially similar to what is recited in claim 6 of US patent 5,996,075. US patent 5,996,075 and the current application is commonly assigned. However, claim 17 and its dependent claims contain several 112, second paragraph problems that must be corrected before they can be allowed. Claims 18-23 depend on claim 17.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PP

Ponnoreay Pich
Examiner
Art Unit 2135



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